REMARKS

The Examiner rejected claims 12, 21, 24-26, 33 and 35-36 under 35 U.S.C. 102(b) as being anticipated by Steensen (2,267,431). The Examiner stated that in Figs. 1-3, Steensen discloses a flexible exhaust pipe suspension for a vehicle exhaust system comprising a vibration insulator (10) having an outer surface, a front surface and a rear surface (Fig. 3). Furthermore, the Examiner stated that Steensen also discloses a heat shield (12) having a cup-shaped body defining a chamber including an inner surface (Fig.2) and that the heat shield and the vibration insulator are complementary shaped. When the vibration insulator is held within the chamber, at least a portion of the outer surface and front surface lie in contact with the inner surface of the chamber. The Examiner further stated that the heat shield is adapted to thermally insulate the vibration insulator from an internal heat. (The Applicant presumes that the Examiner intended to state that the heat shield (12) is adapted to thermally insulate the vibration insulator from an external heat source as is claimed in claim 12 of the instant application and has responded as though this is the statement the Examiner made.)

In response to the Examiner's rejection, Applicant respectfully points out that devices similar to and including the one disclosed in the Steensen reference have long been obsolete in the suspension of automotive exhaust systems. These devices have become obsolete because they are complex, costly and are poor vibration insulators. The nuts and bolts and other metal parts described in the Steensen reference have, by

and large, been replaced by two one piece hangers, one welded (or occasionally bolted) to the vehicle frame or body and the other welded to the exhaust system. Applicant's device is designed to fit over these hangers.

The Examiner suggested that the component numbered by Steensen as (12) is a heat shield. Applicant respectfully disagrees that cap (12) of Steensen is a heat shield. A shield, according to the Oxford Reference Dictionary, is "an object, structure, or layer of material that protects something". One would therefore presume that a heat shield would be an object, structure, or layer of material that protects something from the effects of heat. Applicant respectfully submits that Steensen's cap (12) would not serve this purpose but would, in fact, enhance the effects of heat on the body (10) because cap (12) would directly transmit heat to body (10). According to column 2, lines 34-38 of Steensen, caps 11 and 12 are preferably composed of a malleable metal having considerable rigidity. Metals are very good conductors of heat, especially when they lie in direct contact with the heat source. Steensen discloses that cap (12) is in direct contact or integrally formed with a collet (40) (Fig. 4) or a knuckle piece (50) (Fig. 5). Collet (40) or knuckle piece (50) are, in turn, in direct contact with U-clamp (41) or (51) respectively, and the U-clamp is in direct contact with the exhaust pipe (20). Heat from the exhaust pipe (20) will therefore be conducted through clamp (41 or 51) to the collet (41) or knuckle piece (50) and then into cap (12). Applicant submits that cap (12), because it is made from metal, would conduct that heat from the exhaust pipe (20) to the resilient body (10). This heat transmission would be further enhanced because body (10) may be reinforced with a wire mesh. This wire mesh would transmit the heat from

cap (12) through body (10). This heat transmission through cap (12) would more likely hasten the deterioration of body (10) instead of slowing down its deterioration. Applicant therefore respectfully submits that cap (12) of Steensen is not a heat shield inasmuch as it is not an object, structure of layer of material that protects body (10) from the effects of heat from the exhaust pipe 20. It is, in fact, the opposite of a heat shield - it is a heat conductor. Applicant therefore respectfully submits that the Steensen device does not fall within the limitations of independent claims 12, 26 and 36 as it does not include a heat shield. In order for a reference to anticipate a claim, that reference must show each and every feature of the claimed invention either expressly or inherently. ***In re Row v. Dror***, 42 USPQ 2d 1550, 1553 (Fed. Cir. 1997) (quoting ***Kloster Speedsteel AB v. Crucible, Inc.***, 230 USPQ 81, 84 (Fed. Cir. 1986))

> "A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim. . . . "[A]bsence from the reference of any claimed element negates anticipation."

Applicant submits that because Steensen does not disclose a heat shield that thermally insulates the vibration insulator from an external heat source, that Steensen does not anticipate the invention claimed in claims 12, 26 and 36.

However, in order to more clearly distinguish between Applicant's device and that of Steensen, Applicant has amended independent claims 12, 26 and 36 by defining the heat shield as being a non-metallic heat shield. Applicant has further included the limitation that the heat shield is flexible. The Steensen reference discloses in column 2, line 38 that cap (12) is of "considerable rigidity". Applicant submits that the inclusion of

these two limitations in the independent claims 12, 26 and 36, overcomes the rejection based on anticipation by Steensen. The remaining claims 21, 24, 25, 33 and 35 depend from one of these independent claims. Applicant therefore respectfully requests that the rejection of claims 12, 21, 24-26, 33 and 35-36 under 35 U.S.C. 102(b) as being anticipated by Steensen, be withdrawn.

The Examiner rejected claims 13-18 and 27-32 under 35 U.S.C. 103(a) as being unpatentable over Steensen. The Examiner stated that regarding claims 13-16 and 27-30, Steensen discloses a heat shield (12), which is made from a rigid material, but fail to show the heat shield made from a flexible, heat resistant material, an elastomer, a silicone elastomer from a group ASTM D20, classification GE, FC, FE and FK. The Examiner suggested that it would be a matter related to the choice of ornamentation producing no mechanical effect and take advantage of that select material such as heat resistance, long last or flexible or advantage considered to constitute the invention are considered obvious and do not impart patentability.

In response and as discussed above, Applicant disagrees with the Examiner's statement that Steensen discloses a heat shield. As discussed with reference to the 102(b) rejection, Steensen discloses that cap (12) is made of a rigid metal and that is in direct contact with collet (40) or knuckle piece (50). Collet (40) or knuckle piece (50) is in direct contact with U-clamp (41 or 51 respectively) which is, in turn, in direct contact with the exhaust pipe (20). Heat from the exhaust pipe (20) will therefore be conducted through the clamp (41 or 51) to collet (40) or knuckle piece (50) respectively and then into cap (12). Heat from cap (12) will be conducted directly to insulator 10. Cap (12)

therefore acts as a conductor of heat and not as a heat shield. Applicant therefore submits that not only does Steensen not disclose a heat shield, the patent actually teaches away from the present invention in that it discloses a heat conductor. Furthermore, the Steensen device cannot even protect insulator (10) from the radiant heat from exhaust pipe (20) or from the high ambient temperature. Even if cap (12) was disclosed by Steensen as a heat shield, which it was not, it cannot and does not function as a heat shield. Applicant's device, on the other hand, protects the vibration insulator from the heat radiating from the exhaust pipe and from the high ambient temperature. Furthermore, because the Applicant's heat shield is made from a flexible material, it stretches with the vibration insulator under varied loading and therefore thermally insulates the vibration insulator under varied conditions. There is furthermore no teaching or suggestion in Steensen that a heat shield is necessary or desirable and there is furthermore no teaching or suggestion in the reference that cap (12) is a heat shield. Applicant respectfully submits that this lack of such teaching or suggestion in Steensen, combined with the inability of the cap (12) to function as a heat shield, overcomes the Examiner's rejection of claims 13-16 and 27-30 under 35 U.S.C. 103(a) as being unpatentable over Steensen. Applicant respectfully requests that the rejection of claims 13-16 and 27-30 be withdrawn.

Applicant acknowledges that claims 19-20 and 40-41 are allowed. Applicant further acknowledges that claims 22 and 37-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Applicant has selected not to amend claims 22 and 37-39 until the Examiner has